

Appln. No. 10/063,826
Docket No. 122261/C1EM-0003

REMARKS / ARGUMENTS

Status of Claims

Claims 1-36 are pending in the application and stand rejected. Claims 3, 17-32 and 35 are objected to. Applicant has canceled Claim 34, and has amended Claims 1-3, 15, 17-33, 35 and 36, leaving Claims 1-33 and 35-36 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §101, and 35 U.S.C. §103(a), have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Rejections Under 35 U.S.C. §101

Claim 34 stands rejected under 35 U.S.C. §101 because the Examiner alleges that the claimed invention is directed to non-statutory subject matter.

Applicant has canceled Claim 34 without prejudice, thereby obviating this rejection.

Claim Objections

Claims 17-32 and 35 are objected to because of informalities.

Applicant has amended Claims 17-32 and 35 to correct for the informalities.

Claim 3 is objected to because of lack of antecedent basis.

Applicant has amended Claim 3 to correct for the lack of antecedent basis.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw these objections, which Applicant considers to be obviated.

Rejections Under 35 U.S.C. §103(a)

Claims 1-33 and 35-36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dumoulin (U.S. Patent No. 6,198,282, hereinafter Dumoulin) in view of Miyazaki et al. (U.S. Patent No. 6,320,377, hereinafter Miyazaki).

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Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

The Examiner acknowledges that Dumoulin does not teach the use of nested pulses or multiple sequences, and looks to Miyazaki to cure this deficiency.

Applicant has amended independent Claims 1, 17, 33, 35 and 36 to now recite, inter alia, "... said nested pulse having portions *coincident with* said nesting pulse."

No new matter has been added as antecedent support may be found in the specification as originally filed, such as at paragraph [0037-0038] and at Figures 3, 4 and 9, for example.

Here, Applicant discloses and claims gradient magnetic field pulses where the pulses for the slice selection gradient field and the readout field are nested or coincident.

In looking to Miyazaki to cure the deficiency of Dumoulin, the Examiner cites Miyazaki at column 13, line 59-62. Paper No./Mail Date 2, page 3.

In comparing Miyazaki as cited with the instant invention, Applicant finds Miyazaki to teach "*sequential-mode nesting*". Column 13, line 60, and Figures 11 and 12B.

In view of Miyazaki teaching *sequential nesting*, it follows that Miyazaki necessarily does not teach *coincidental nesting*, as specifically claimed for in the instant invention.

If Miyazaki were to be combined with Dumoulin as suggested by the Examiner, one skilled in the art would arrive at *sequential nesting* and not *coincidental nesting*. Accordingly, the combination of Miyazaki and Dumoulin does not teach or suggest each

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and every element of the claimed invention, and does not motivate one skilled in the art to do what only the Applicant has done.

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and disclose a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

In light of the forgoing, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §101 and 35 U.S.C. §103(a) have been traversed, and respectfully requests that the Examiner reconsider and withdraw these rejections.

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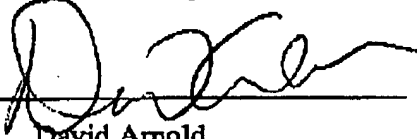
The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 07-0845.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

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